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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,590	04/03/2002	Zhi Xian Chen	2577-124A	1775

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,590	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> Anne R. Kubelik	<b>Art Unit</b> 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005 and 01 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-18 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The objection to claims 2-18 because of informalities is withdrawn in light of Applicant's amendment to the claims.
4. The rejection of claims 1-18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is withdrawn in light of Applicant's amendment to the claims.

### ***Claim Rejections - 35 USC § 102***

5. Claims 1-6 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Strickland (WO 97/12512). The rejection is repeated for the reasons of record as set forth in the Office action mailed 7 October 2004. Applicant's arguments filed 7 January 2005 have been fully considered but they are not persuasive.

Applicant urges that in the examples Strickland used hypocotyls, and no examples are provided of transformation of callus from other plant tissues, including petioles or with hormone free regeneration (response pg 15).

This is not found persuasive because literal examples are not necessary. Strickland's claims and specification teach the instantly claimed method.

Applicant urges that on pg 11 Strickland asserts but does not demonstrate that hormone free regeneration is applicable, but he was merely predicting that hormone free regeneration could work (response pg 15-16).

This is not found persuasive. The instant application shows that Strickland's predictions were correct. It is noted that only a reasonable expectation of success is required for determinations of obviousness, as taught in *In re O'Farrell*, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988).

Applicant urges that Strickland's prediction is not supported by the disclosure, as only hypocotyls were used, and other tissues had not even been successfully transformed at the time Strickland's application was filed (response pg 16).

This is not found persuasive because Strickland's predictions were correct.

Applicant urges that embryogenic calli does not necessarily form somatic embryos and these do not necessarily regenerate into plants; Strickland demonstrates neither, and the kanamycin resistance used does not necessarily indicate successful integration (response pg 16).

This is not found persuasive because literal examples are not necessary. Strickland's claims and specification teach the instantly claimed method. The instant method has no features not in Strickland's claims and specification.

Applicant urges that US Patent 5,846,797 does not have claims to petioles, supporting Applicant's assertion that Strickland does not disclose a method for preparing a transgenic cotton plant using petioles (response pg 17).

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This is not found persuasive. The examiner cannot comment on another patent and has no knowledge of the prosecution history of '797. However, even if petiole transformation had been considered not enabled, that would not preclude anticipation of the instant claims.

See *In re Hafner*, 161 USPQ 783 (CCPA 1969) at pg 785, where it says

In essence, appellant is contending that a double standard should not be applied in determining the adequacy of a disclosure to anticipate under §102, on the one hand, and to support the patentability of a claim under §112 on the other. He feels that a disclosure adequate for the one purpose is necessarily adequate for the other but, unhappily for him, this is not so. As we shall develop, a disclosure lacking a teaching of how to use a fully disclosed compound for a specific, substantial utility or of how to use for such purpose a compound produced by a fully disclosed process is, under the present state of the law, entirely adequate to anticipate a claim to either the product or the process and at the same time, entirely inadequate to support the allowance of such a claim....

Standing alone, appellant's argument against a double standard is a plausible proposition. However, when considered in light of the specific provisions of §102, and §112 as it has been interpreted, it is seen to be untenable—§112 provides that the specification must enable one skilled in the art to "use" the invention whereas §102 makes no such requirement as to an anticipatory disclosure. The disclosure of how to use must relate to a use of the kind considered by the Supreme Court in *Brenner v. Manson* to be a sufficient utility.... Thus, the double standard which appellant criticizes is now, implicitly if not explicitly, required by law, at least in situations such as we have here, although the "invention" per se claimed is fully disclosed and though the manner of "making," as distinguished from "using," the invention is also fully disclosed or is obvious.

See *In re Schoenwald* (CA FC) 22 USPQ2d 1671, at pg 1673, where it says

... [A]ppellant is contending that a double standard should not be applied in determining the adequacy of a disclosure to anticipate under Section 102, on the one hand, and to support the patentability of a claim under Section 112 on the other. He feels that a disclosure adequate for the one purpose is necessarily adequate for the other but, unhappily for him, this is not so.... [A] disclosure lacking a teaching of how to use a fully disclosed compound for a specific, substantial utility or of how to use for such purpose a compound produced by a fully disclosed process is, under the present state of the law, entirely adequate to anticipate a claim to either the product or the process and, at the same time, entirely inadequate to support the allowance of such a claim.

### ***Claim Rejections - 35 USC § 103***

6. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strickland (WO 97/12512) in view of Finer (1988, Plant Cell Rep. 7:399-402). The rejection is repeated for the reasons of record as set forth in the Office action mailed 7 October 2004. Applicant's arguments filed 7 January 2005 have been fully considered but they are not persuasive.

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Applicant urges that Strickland does not provide a method for producing transgenic cotton using petioles as explants, but merely hopes that they would work (response pg 18).

This is not found persuasive for the reasons indicated above.

Applicant urges that Finer does not provide further disclosures to overcome the deficiencies of Strickland (response pg 18).

This is not found persuasive because Finer teaches embryoid formation within 2 weeks in a culture media with 15 mM (about 2.2 g/l) glutamine as a nitrogen source (pg 400, left column, paragraph 1).

Applicant urges that Strickland's teachings of a method for generating callus from hypocotyls explants on medium using no hormones teaches away from Finer, who used hormones (response pg 18).

This is not found persuasive because Strickland teaches media with 0 mg/ml of 2,4-dichlorophenoxyacetic acid. The rejection was not applied to claim 18.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

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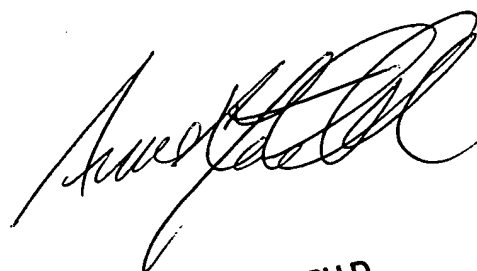
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.  
April 26, 2005



**ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER**